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OFFICE OF PETITIONS

In re Application of	:	
Kaneko et al.	:	DECISION ON APPLICATION
Application No. 09/925,673	:	FOR
Filed: August 9, 2001	:	PATENT TERM ADJUSTMENT
Atty Docket No. 01376CIP/HG	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE filed September 6, 2007. Applicants request that the initial determination of patent term adjustment set forth in the Notice of Allowance mailed July 26, 2007 be corrected from one hundred ninety-five (195) days to four hundred seventy-three (473) days.

The application for patent term adjustment is DISMISSED.

On July 26, 2007, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 195 days.

Applicants assert that a period of adjustment of two hundred seventy-eight (278) days should be entered. Specifically, applicants assert that in response to the Corrected Notice of Allowance and Fee(s) Due mailed April 5, 2005, the Issue Fee was paid on June 27, 2005. The application was withdrawn from issue by the USPTO in a paper entitled NOTICE OF WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(c) mailed June 22, 2006. An Office action was then mailed on August 1, 2006. It is requested that

applicants be afforded a 278-day USPTO delay from four months after the payment of the Issue Fee on June 27, 2005 to the mailing date of the Office action on August 1, 2006. Petitioner argues that the USPTO failed to respond within four months of the aforesaid payment of the Issue Fee on June 27, 2005, as required by 37 CFR 1.702(a)(2).

Applicants state that any patent granted on this application is not subject to a terminal disclaimer.

Applicants' arguments have been considered, but not found persuasive. First, of all, the relevant section to consider Office delay is 1.702(a)(4), not (a)(2). 37 CFR § 1.702(a)(4) provides that:

subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent not later than four months after the date on which the issue fee was paid under 35 U.S.C. 151 and all outstanding requirements were satisfied.

Section 1.703(a)(6) pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(iv) and § 1.702(a)(4). Section 1.703(a)(6) specifies that:

the period is the number of days, if any, beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date the patent was issued.

As stated in the final rule:

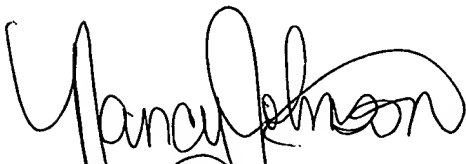
the date the issue fee was paid and all outstanding requirements were satisfied is the later of the date the issue fee was paid or the date all outstanding requirements were satisfied. However, if prosecution in an application is reopened after allowance (see MPEP 1308), all outstanding requirements are not satisfied until the application is again in condition for allowance as indicated by the issuance of a new notice of allowance under 35 U.S.C. 151 (see MPEP 1308). See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000).

Accordingly, in this instance, the date of payment of the issue fee on June 27, 2005 is not controlling. After payment of the issue fee, prosecution was reopened with the mailing of a NOTICE OF WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(c) mailed June 22, 2006. A new Notice of Allowance was mailed on July 26, 2007, and the Issue Fee transmittal was again submitted on September 27, 2007.

Applicants' submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

The application is being forwarded to the Publications Division for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



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